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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,716	03/29/2001	Yanki Margalit	U 013371-4	4639

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Ladas & Parry
26 West 61 Street
New York, NY 10023

EXAMINER

PYZOCHA, MICHAEL J

ART UNIT	PAPER NUMBER
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2137

DATE MAILED: 03/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/821,716

Applicant(s)

MARGALIT ET AL.

Examiner

Michael Pyzocha

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-441 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 44-70, 118-129, 184-210, 281-307, 378-404, 433, 436 and 439 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) See Continuation Sheet are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- 1) ☐ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 04032001, 02132004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims subject to restriction and/or election requirement are 1-43,71-117,130-183,211-280,308-377,405-432,434,435,437,438,440 and 441.

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DETAILED ACTION

1. Claims 1-441 are pending.

Election/Restrictions

2. Applicant's election without traverse of Group II claims 44-70, 118-129, 184-210, 281-307, 378-404, 433, 436, and 439 in the reply filed on 01/03/2005 is acknowledged.

3. Claims 1-43, 71-117, 130-183, 211-280, 308-377, 405-432, 434-435, 437-438, 440-441 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1/3/05.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 44-70, 118-129, 184-210, 281-307, 378-404, 433, 436, and 439 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and

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distinctly claim the subject matter which applicant regards as the invention.

Claims 44, 63, 118, 126, 184, 203, 281, 300, 378, and 397 contains the trademark/trade name Bluetooth. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe Bluetooth communication protocols and, accordingly, the identification/description is indefinite.

Any claims not specifically addressed are rejected by virtue of their dependencies.

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Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 44-47, 51-54, 61, 63-64, 66, 118-120, 124, 126-127, 184-187, 191-194, 201, 203-204, 206, 281-284, 288-291, 298, 300-301, 303 are rejected under 35 U.S.C. 102(e) as being anticipated by Leon (US 6680923).

As per claims 44, 118, 184, 281, Leon discloses a device capable of communicating with a communication network via a Bluetooth communication protocol, said device including at least one authentication functionality at least part of at least one of which forms part of said Bluetooth communication protocol (see column 4 lines 59-65 and column 5 lines 54-58).

As per claims 45-47, 119-120, 185-187, 282-284, Leon discloses the device is effective to identify itself and another device to an authenticator (see column 5 lines 54-58).

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As per claims 51-54, 191-194, 288-291, Leon discloses the device includes substantial non-authentication functionality, with the ability to identify another device and the device is a telephone or a PDA (see column 4 lines 59-65).

As per claims 61, 63-64, 66, 124, 126-127, 201, 203-204, 206, 298, 300-301, 303, Leon discloses at least one authentication functionality is selected from the following authentication functionalities: a cryptographic authentication functionality; a password based authentication functionality; a smartcard based authentication functionality; a token based authentication functionality; and a biometric based authentication functionality with previously discussed limitations (see column 4 lines 59-65 and column 5 lines 54-58).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. Claims 48, 57-58, 60, 62, 67-68, 70, 121-123, 125, 128-129, 188, 197-198, 200, 202, 207-208, 210, 285, 294-295, 297, 299, 304-305, and 307 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leon as applied to claims 44, 118, 184 and 281 above, and further in view of Menezes et al (Handbook of Applied Cryptography).

As per claims 48, 121, 188, 285, Leon fails to disclose the device is effective to identify a user for authentication.

However, Menezes et al teaches such a limitation (see page 387 where biometrics identify a user).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Menezes et al's biometrics to identify a user of Leon's device.

Motivation to do so would have been to use human physical characteristics and involuntary actions to identify a user.

As per claims 57-58, 60, 62, 67-68, 70, 122-123, 125, 128-129, 197-198, 200, 202, 207-208, 210, 294-295, 297, 299, 304-305, 307, the modified Leon and Menezes et al system discloses the use of more than one authentication technique with limitations already discussed above (see Leon column 5 lines 54-58 and Menezes et al page 387).

10. Claims 49-50, 59, 65, 69, 189-190, 199, 205, 209, 286-287, 296, 302, 306 are rejected under 35 U.S.C. 103(a) as being

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unpatentable over Leon and the modified Leon and Menezes et al system as applied to claims above, and further in view of Hoffpauir et al (US H001918 H).

As per claims 49-50, 59, 65, 69, 189-190, 199, 205, 209, 286-287, 296, 302, 306, Leon and the modified Leon and Menezes et al fail to disclose the use of a dedicated authentication device.

However, Hoffpauir et al teaches such a device (see column 2 lines 1-20).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Hoffpauir et al's dedicated device to perform the authentication of Leon and the modified Leon and Menezes et al system.

Motivation to do so is that authentication requires extensive processor power and capability.

11. Claims 55-56, 195-196, 292-293 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leon as applied to claims 51, 191, 288 above, and further in view of Cameron et al (US 20030055735).

As per claims 55-56, 195-196, 292-293, Leon fails to disclose the device is a computer and an electronic wallet.

However, Cameron et al teaches these Bluetooth devices (see paragraph 172).

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At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Cameron et al's devices in Leon's authentication device.

Motivation to do so would have been to boost the success of Bluetooth.

12. Claims 378-404 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leon alone and in combination with Menezes et al, Hoffpauir et al, and Cameron et al as applied to claims above, and further in view of Hall et al.

As per claims 378-404, 433, 436, 439, Leon alone and in combination with Menezes et al, Hoffpauir et al, and Cameron et al discloses the claimed limitations as in the claims above, but fails to disclose the added limitation of multi-tier authentication.

However, Hall et al teaches a multi-tier system (see column 4 lines 51-64).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Hall et al's multi-tier system to relay the authentication of Leon alone and in combination with Menezes et al, Hoffpauir et al, and Cameron et al.

Motivation to do so would have been to use an intermediate system to communicate with a different device.

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Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tess is a printout of the trademark for Bluetooth, Hale teaches the need and methods for Bluetooth authentication, Brown et al, Lemilainen et al, Baird, III et al teach Bluetooth authentication, Roskind and Wright et al teach multi-tier authentication and Walker et al teaches a dedicated authentication device.

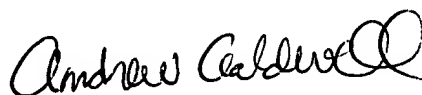
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (571) 272-3875. The examiner can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJP

A handwritten signature in black ink, appearing to read "Andrew Caldwell", with a stylized flourish at the end.

ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER